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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957.

No. 964.

LOU JOHNSON CO., a corporation, MEIER & FRANK CO., INC., a corporation, ADMIRAL CORPORATION, a corporation, and AMANA REFRIGERATION, INC., a corporation,

Petitioners,

vs.

MOIST COLD REFRIGERATOR CO., INC., a corporation,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Opinions Below.

The Opinion of the District Court is not reported but appears at R. 72 of the printed record and in footnote 4 to the Opinion of the Court of Appeals. The Opinion of the Court of Appeals for the Ninth Circuit (App. to Petition, p. 1a) is reported at 249 F. 2d 246.

Jurisdiction.

The jurisdictional requisites are adequately set forth in the Petition at page 2.

Questions Presented.

Where the jury returned a verdict for the plaintiff (respondent here) that the patent in suit was valid and infringed by defendants (petitioners here), was the Court of Appeals correct in setting aside the District Court's final judgment for defendants notwithstanding the verdict, where

1. the Court of Appeals, reversing the District Court's contrary conclusion of law, held that there was substantial evidence, in support of the jury verdict, that the patent satisfied the rigorous standards of invention laid down in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147;

2. the Court of Appeals, reversing the District Court's contrary conclusion of law, held that there was substantial evidence, in support of the jury verdict, that the specification of the patent made the disclosure required by the Patent Law, 35 U. S. C. A. §112, concerning the existence of a fin coil or other extended surface coil;

3. the Court of Appeals, reversing the District Court's contrary conclusion of law, held that there was substantial evidence, in support of the jury verdict, that the claims of the patent were sufficiently definite to satisfy the patent statute;

4. the Court of Appeals, reversing the District Court's contrary conclusion of law, held that there was substantial evidence, in support of the jury verdict, that the "cold wall" of the accused structures exemplified the extended surfaces of the patent claims' cooling expander;

5. the Court of Appeals, reversing the District Court's contrary conclusion of law, held that there was substantial evidence, in support of the jury ver-

dict, that the accused structures had a single liquefying unit of the kind defined in the patent claims; and

6. the Court of Appeals agreed with the District Court that there was no other ground for entering final judgment for defendants notwithstanding the jury's verdict for the plaintiff.

Statutes Involved.

The pertinent provisions of the patent statutes are set forth in the Petition at page 5 and App. 29a-32a.

Statement.

The statement of the case in the opinion of the Court of Appeals is sufficient for present purposes.

ARGUMENT.*

1. Question of invention: Petitioners' asserted reasons for granting the writ are based on serious distortion of decision below.

Petitioners' formal reasons for granting the writ—question of importance in administering the patent laws, and alleged conflict with the decisions of this Court and of Courts of Appeals—are all predicated on the same, obvious misreading by petitioners of the instant decision of the Court of Appeals. That decision, without petitioners' contrived misinterpretation of it, is nothing but a run-of-the-mill, plainly correct, application of this Court's decision in *A. & P.* v. *Supermarket, supra,* consistent with the

* Numbers herein correspond to numbers in Section of this Brief headed "QUESTIONS PRESENTED."

other decisions cited by petitioners, and resulting, not in any final judgment, but only in direction of a new trial on all issues (App. to Petition, p. 28a).

Petitioners' whole case for granting the writ is the Court of Appeals' supposed holding, in respect of the issue of invention, "that the question of validity of a patent, and particularly the standards of invention, is a question of fact rather than one of law" (Petition, p. 8). The opinion below, written in clear English, holds no such thing.

The Court of Appeals first laid down as the applicable "rule" of law, "the rigid standards of invention of . . . *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* . . ." (249 F. 2d, at 252-3; App. to Petition, 12a-14a); then "with this strict rule in mind", appraised the evidence pertinent to the issue of whether the patent satisfied the said standards of invention (249 F. 2d, at 253-254; App. to Petition, 14a-17a). The purpose of the appraisal was to determine the "question . . . of law" whether the jury finding of fact—of "a new, useful, and unexpected result", of the "whole . . . exceed[ing] the sum of its parts"—was supported by substantial evidence (249 F. 2d, at 252, 254, 256; App. to Petition, 11a, 16a-17a, 23a).

In its careful demarcation of law and fact questions, the Court of Appeals followed the *A & P* decision. There, the Supreme Court held that it is error of law to use "a standard of invention . . . less exacting than that" spelled out in the Opinion (340 U. S. 147, 154). Thus, a combination patent is invalid, as a matter of law, unless the "old elements which made up this device perform any additional or different function in the combination than they perform out of it." (340 U. S., at 152). But the question whether they do perform an added or different function in the com-

bination is a question of fact; this Court made that clear by pointing out that "neither court below has made any *finding*" to that effect respecting the device there in suit (340 U. S., at 152, emphasis supplied). Of course, as *A & P* also makes evident, whether there is substantial evidence supporting any finding of fact is itself a question of law (340 U. S., at 149. Accord: *Montgomery Ward & Co.* v. *Duncan*, 311 U. S. 243, applied below, 249 F. 2d, at 251-2; App. to Petition, 9a-11a).

Moreover, the Court of Appeals in the instant case did nothing inconsistent with the *A & P* concurring opinion of Douglas and Black, JJ. That opinion pointed out that "No 'finding of fact' can be a substitute for it in any case"; namely, " 'the standard of invention' . . . which the Court must decide", "as a question of law" (340 U. S., at 155-6).

None of the Court of Appeals decisions cited in the Petition (at 9-11) shows any conflict requiring Supreme Court resolution by review of the instant decision. The only ones petitioners discuss at all (pp. 10-11) were decided by the same Circuit that decided the case at bar. In the *Bergman* case from that Circuit, 251 F. 2d 801, petitioners' primary reliance, Judge Pope's concurring opinion expressly characterizes the putative conflict as "more apparent than real" (251 F. 2d, at 810) and the first opinion in that case contains Section 2 entitled, "A Patent Case Presents Mixed Questions of Law and Fact" (251 F. 2d, at 803). On the very ground of asserted conflict among those decisions, including the present one, on the matter of law and fact questions, petitioners asked for review by the Ninth Circuit *en banc* which was denied (Petition, p. 2). Denial of that application negatives the alleged intra-circuit conflict, which is a figment of petitioners' imagination as is the supposed conflict between the Ninth and the other Circuits or between the case at bar and the *A & P* decision.

Contrary to petitioners' unsupported assertion, the Court of Appeals, as its opinion plainly shows, painstakingly and correctly applied this Court's decision in *A & P*. Nowhere do petitioners even suggest that the Court of Appeals used a standard of invention "less exacting" (340 U. S., at 154) than that laid down in *A & P*. That the Court of Appeals "scrutinized the claims in the light of this rather severe test" (340 U. S. at 152) is really conceded by petitioners and is, in any event, evident from the opinion. Moreover, petitioners do not deny, and the opinion and record demonstrate, that the fact finding—of an unexpected, added or different, function in the combination making the whole exceed the sum of its parts—was substantially supported in the evidence. Indeed, respondent's position is that any contrary finding would not have substantial support in the record.

2. Required disclosure in specification.

Petitioners' Argument heading 2 (p. 11) refers to "sufficiency of the specifications" but they postpone their own discussion of this point until heading 3 (p. 13) which purports to discuss the entirely different point of alleged late claiming. Petitioners' discussion (pp. 13-15) of the sufficiency of disclosure of the specification is as confused as the arrangement of their points for argument, in line with their distortion of the holding below on invention. Whether intended or not, the petitioners' objective appears to be, to prompt this Court to project petitioners' confusion onto the Court of Appeals.

Thus, petitioners (Petition, p. 12) snatch at the citation in the opinion below (249 F. 2d, at 254, App. to Petition, 18a) of *Anraku* v. *General Electric Co.*, 80 F. 2d 958, 963 (C. A. 9) and purport to see a conflict therein between the

decision below and this Court's decision in *General Electric* v. *Wabash Appliance Corp.*, 304 U. S. 364. The supposed conflict evaporates upon examination of the point for which the Court of Appeals cited *Anraku;* namely, as to specifications, "Whether or not a disclosure is sufficient is a question of fact." In *General Electric* v. *Wabash,* this Court did not purport to unsettle that well-established rule concerning *specifications,* but decided the entirely different point that the patent in *Anraku,* the same one as in *Wabash,* was invalid for functional statement of *claims* "at the exact point of novelty" (304 U. S., at 371).

Contrary to petitioners' ungrounded assertions (13-14, 15), the Court of Appeals did *not* hold "that plaintiff tacitly conceded that this essential element ("fin coil or other extended surface coil") was not shown in the drawings" or "that the drawings of the Bronaugh and Potter patent did not disclose this essential element of the invention". What the Court of Appeals did hold, as to the drawings, was: (1) plaintiff "tacitly concedes that the particular kind of heat withdrawing surfaces, or their particular dimensions, were not shown in the drawing"; but (2) "the testimony" was "that an expert by merely looking at the drawing could tell that a fin coil or a brine tank was described" (249 F. 2d, at 254; App. to Petition, 18a, 17a). "Fin" and "brine tank" are each instances of extended heat withdrawing surfaces (R. 761, 887, 895, 1171, 1190) and the patent did not, as a matter of law, the Court of Appeals held, have to distinguish between one kind of extended surface and another; because the combination incorporated extended surfaces as an old element whether exemplified in "fin", "brine tank", or another kind of extended surface. In short, the drawing disclosed an extended surface, an old, stock, element in the new combination, but not any particular one

of the many well-known exemplifications of this element old in the art.

With respect to the language of the specification, petitioners, in stating (p. 14) that it does not make adequate disclosure of the extended surface coil in the cooling compartment, simply ignore the record and the holding of the Court of Appeals. The Court, appraising the evidence, concluded that there was substantial record support for the fact finding that the language of the specification did adequately disclose, to one skilled in the art, the means of making the patent device, which included the old cooling evaporator or extended surface coil (249 F. 2d, at 254; App. to Petition, 17a-18a).

Stewart-Warner cited by petitioners (p. 14) is not apposite. Apart from the fact that that case concerned the old patent and a different trial record, the statement quoted was only dictum because the decision in that case went off on the sole ground that the original patent claims were functional in form (the reason for obtaining the reissue patent now in suit). And in any event, all the quoted dictum says is, that the specification did not disclose a "special kind of coil". That is not inconsistent with the instant holding that enough was shown to warrant the finding that the specification adequately disclosed the means, including the old, well-known element of an extended surface coil, without regard to any special kind thereof.

3. Required definiteness of claims.

The only point petitioners make in this connection (see Petition, p. 13) is alleged functional statement of claims. Their reliance here on *Stewart-Warner* is indeed peculiar, since it was that very decision that caused surrender of the original patent and reissue of the patent in suit with-

out the language there held to be formally objectionable. The functional statement defense, as to the reissue patent, was overruled by the Court of Appeals for the Ninth Circuit in this case on the prior appeal, in 217 F. 2d 39, and this Court denied certiorari, 348 U. S. 952 (see opinion below, 249 F. 2d, at 250-1; App. to Petition 6a-8a). Subsequently, at the trial below, defendants expressly abandoned this defense (R. 1489), presumably because they recognized its obvious unsoundness under this Court's decision of *Faulkner* v. *Gibbs*, 338 U. S. 267 and §112 of the Patent Code, as applied to the combination claims of the reissue patent. Neither the District Court nor the Court of Appeals mentioned this defense, doubtless because it was so plainly untenable and out of the case by petitioners' abandonment.

The District Court nowhere particularized any respect in which the claims are alleged to be vague. The Court of Appeals held that the record substantially supported the finding of sufficient definiteness of claims (249 F. 2d, at 254-5; App. to Petition 18a-20a). Petitioners here still give no particularization of their assertion that the claims are insufficiently definite.

4. and 5. Infringement Questions.

Petitioners do not question the holdings of the Court of Appeals on infringement.

6. Other Questions.

Neither the Court of Appeals nor the District Court sustained the two added defenses which petitioners now seek to raise; namely, alleged late claiming and alleged anticipation.

A. Alleged Late Claiming.

This defense of late claiming, properly rejected by the Court of Appeals and the District Court,* is based on two misconceptions: (1) the applicable law and (2) the earliest filing date plaintiff is entitled to.

(1) Under *Muncie Gear* v. *Outboard*, 315 U. S. 759, a claim is not invalid for delay of over two years in presenting it as such (under the law applicable to our case) after a public sale or use of the device of the claim, when, as here, the first *disclosure* thereof was made to the Patent Office within that period. It is the disclosure date that counts.**

Such disclosure is sufficient if an apparatus be clearly so shown, by the specification and drawings, as to have a certain operating characteristic although not named or mentioned with particularity in the specification *Bickell* v. *Smith-Hamburg-Scott*, 53 F. 2d 356, at 358 (C. A. 2). An amendment to the specification is justified by reference to the first drawing, for as stated in *Wagenhorst* v. *Hydraulic Steel*, 27 F. 2d, 27, 31 (C. A. 6):

> "What clearly appears by a drawing though not fully described may be a sufficient disclosure (citing cases). To insert by amendment a fuller description of what completely appears by the original drawing and was intelligibly described is not to insert new matter (citing cases)."

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* The *General Electric* decision (Petition, pp. 4, 16), on motion as to only claim 11 of the original patent, was based upon no facts like those of record here. Also, that claim was surrendered in 1948. See record on the former appeal, pp. 85-9.

** *Accord: Jacquard Knitting Machine* v. *Ordnance Gauge*, 95 F. Supp. 902, 108 F. Supp. 59, 213 F. 2d 503 (C. A. 3). See also: *Proctor and Gamble Mfg. Co.* v. *Refining Inc.*, 135 F. 2d 900 (C. A. 4); *R. U. V. Engineering Corp.* v. *Borden Co.*, 170 F. 2d 688 (C. A. 2).

The defendants have the burden; and the administrative determination of the Patent Office in allowance of an amendment without objection to it as containing new matter, is entitled to great weight in this connection. *Bickell, supra.*

(2) The Barry box was built about October 30, 1930 and since the "Barry box" stayed on Potter's floor for a long time after it was built, it was not sold until about October 1931 (R. 300-301). Thus the only sale defendants point to was well within two years of December 2, 1932 when defendants admit, in their brief below (D. Br. 57), that a "non-frosting" coil was mentioned. A "non-frosting" food storage compartment is named in the originally filed specification (D. Ex. 101, p. 16). Adequate disclosure was clearly made in the very first application for the original patent, which application was filed February 16, 1931 (D. Ex. 101, p. 1).

Additionally, the administrative decision of the Patent Office holding the fuller description to be not new matter, is presumptively correct and the patent is entitled to its filing date of February 16, 1931 for the explanations added in 1934.

B. Alleged Anticipation.

Petitioners now assert (p. 17) that Davenport patent No. 1,726,344 (D. Ex. 107) anticipated the patent in suit. This defense was also properly rejected by both courts below.

Davenport patent No. 1,726,344, unlike the patent in suit, (i) is completely silent on the humidity problem and makes no attempt to solve it and (ii) makes no disclosure of or claim to two different *heat-exchange surface* temperatures, operating simultaneously and continuously, one below 32° F for the freezing compartment and the other above 32° F for the cooling compartment. The only

record reference defendants have given; namely, in their brief below (D. Br. 36), in an effort to show the contrary, is the Davenport patent itself, page 3, lines 13 and 14. But that patent, in speaking of "ordinary refrigerating temperatures," is plainly talking about the ordinary compartment temperatures in the conventional household refrigerator; namely, above 32° F in the *air* of the cooling compartment but below 32° F at the *heat-exchange surfaces, with consequent frosting of the coil and dehydration of the food in said compartment.*•

In fact, Davenport filed patent No. 1,731,711 (D. Ex. 109) "as an improvement and further development" (p. 1, lines 20-26) of No. 1,726,344 ("Serial No. 105,372"), based upon the very fact that the cooling evaporator of No. 1,726,344 frosts.•• The entire substance of his "development" of 1,726,344 is that during "de-frosting" "the frost is thereupon automatically transferred . . . to the freezing element . . ." (*id.* at p. 2, lines 81-94).† Moreover, Daven-

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• More precisely, Davenport used the phrase "ordinary refrigerating temperatures" to refer only to the temperatures of the air in the compartment *and not at all to extended surface temperatures.* This is shown by the context in which the phrase occurs (p. 3, lines 6-17). The sentence in question refers to the "*chamber* from which heat is to be extracted" and suggests how to "secure" an economical "contact area for heat removal to maintain ordinary refrigerating temperatures". Maintain them where? Obviously in the "*chamber* from which heat is to be extracted." (Emphasis supplied.)

•• There is no extended surface unless the total heat exchange area exposed to the air to be cooled exceeds the area of that portion of the evaporator which carries the refrigerant. There is no proof that this is so of Davenport's "extended element", which is not different in principle from Anderson's lengthened coil. Despite Davenport's own admission of frosting, defendants had the temerity to imply below that "extended element" means the same as "extended surface" (D. Br. 35, 36). An extended element serves Davenport's objective (maximum heat absorption in minimum cubic space) but not that of the patent in suit.

† No. 1,731,711 (p. 1, line 53) also describes No. 1,726,344 as "utilizing the vapor-gas principle" (not the single refrigerant principle of the patent in suit).

port *after* applying for Patent No. 1,726,344 applied for another patent (No. 1,769,112, D. Ex. 101) in which he stated that it was "impossible" to do what the patent in suit actually did; *viz.,* use only a single below freezing evaporating temperature and get balanced above and below freezing heat-exchange surfaces.

Defendants' defense of anticipation by Davenport is not only wholly unsupported, but is reduced to the absurdity of asserting that Davenport had done what he himself later said it was impossible to do.

Defendants (Petition, p. 17) quote the axiom from *Knapp* v. *Morss,* 150 U. S. 221, 228:

> "that which infringes, if later, would anticipate if earlier."

But Davenport could not possibly infringe any claim of the patent in suit, for he does not have "a humidity whose relative value is at least 100% at 32° F"; nor any "heat-conducting surfaces within said cooling compartment constructed and arranged to maintain . . . a temperature above 32° F" (patent in suit, all claims). Equally clearly, there could be no such infringement, by Davenport, of claims 3 and 4 of the patent in suit which calls for "insulation around said cooling compartment offering less resistance to flow of heat thereto" than around the freezing compartment co-acting with "a thermostat responsive to the temperature in said cooling compartment."

Conclusion.

We have no difficulty in distinguishing Mr. Justice Douglas' "caustic 'list of incredible patents' " from the substantial advance established in this case. The patent in suit solved a technical problem which had baffled the elec-

tric refrigeration industry from its beginning, reversed prior art thinking, and established the standard two-climate direct expansion household refrigerator of the past twenty years. The novel refrigerating system here is no mere gadget.

The Court of Appeals, against plaintiff-respondent's contention, affirmed the order for a new trial. Petitioners thus seek review of what is, in reality, a non-final determination. Should this Court grant the writ, we ask review and reversal of the new trial order, with direction of entry of final judgment on the verdict for the plaintiff.

The Petition for Certiorari should be denied; if granted, the scope of the review should be as above indicated.

Respectfully submitted,

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